

REMARKSGenerally

Claims 1-24 are pending in the application. Claims 12-24 are withdrawn from consideration. Claims 1-3 and 6 stand rejected under 35 USC 102(e) as being anticipated by U.S. Pat. App. Pub. No. US 2003/0115137 A1 to Rowe (hereinafter "ROWE"). Claims 4 and 8-11 stand rejected as being unpatentable over ROWE in view of U.S. Pat. App. Pub. No. US 2001/0047310 A1 to Russell (hereinafter "RUSSELL"). Claims 5 and 7 stand rejected as being unpatentable over ROWE in view of U.S. Pat. App. Pub. No. US 2003/0097331 A1 to Cohen (hereinafter "COHEN").

This Reply amends Claim 1 by incorporating the limitations of Claim 6 into Claim 1 and canceling Claim 1. The Final OA does not state a *prima facie* case of unpatentability for amended Claim 1 and for Claims 2-11 at least for the reasons cited in detail with respect to each claim.

For each rejection under 35 U.S.C. §103 in this application, the Final OA does not provide a sufficient explanation for combining the references. In each case of rejection under §103, the Final OA recites substantially:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow <Reference #1>'s teaching to include the feature of <the limitation asserted to be disclosed by Reference #2> as taught by <Reference #2> for <the utility asserted by applicant>.

Under this rationale, any collection of disclosures (however unrelated) reciting the elements of a claim can be asserted to render a truly useful/novel/non-obvious invention *prima facie* unpatentable under 35 U.S.C. §103, thereby inappropriately shifting the burden to the applicant. Since all but a very few of otherwise patentable inventions are combinations of known elements, virtually nothing would be patentable if such a formulaic rationale were sufficient to establish a *prima facie* case of unpatentability.

Regarding Rejection of Claims 1-3 and 6 Under 35 USC §102(e) as Unpatentable Over ROWE

With regard to the subject matter of Claim 6, the Final OA asserts:

Rowe teaches the service provider computer is programmed to permit the user to authorize the sub-account to independently transfer electronic tokens to the sub-account (¶52).

The referenced portion of Rowe discloses:

An allowance account is preferably of the type where funds are arranged to be periodically transferred into the account. Such an account may be extremely useful to parents having children. In accordance with this account arrangement, funds are periodically transferred into the account for subsequent use. The funds may be transferred from another established account, or an account or other source not associated with the account provider. For example, parents may establish a customer account from which funds are periodically transferred, such as every two weeks, into an allowance account which is accessible by one or more of their children. These children may access the allowance account to pay for books and the like. In this manner, the parents may control (and as described below, track) the spending of their children or other parties which have access to the account.

There is clearly no mention of authorizing a sub-account to independently transfer electronic tokens to the subaccount. An examination of the remainder of Rowe and the other references of record in this case reveal no disclosure directed to the limitation(s) of Claim 6.

With regard to Claims 1-3, Claim 1 and, by dependency, Claims 2-3 have been amended to include the limitation(s) of Claim 6; and Claim 6 has been canceled.

Given that no *prima facie* case of unpatentability has been stated with respect to amended Claims 1-3, the undersigned requests that the rejection of those claims as unpatentable over ROWE be withdrawn.

Regarding Rejection of Claims 4 and 8-11 as Unpatentable over ROWE in View of RUSSELL.

Regarding Claim 4, that claim is allowable as dependent on Claim 1 as amended.

Regarding Claim 8, the Final OA asserts at P04:

Rowe does not explicitly teach ... configure the sub-account to automatically add funds during a transaction if a balance of the sub-account falls below a minimum balance. However, Russell teaches this matter (¶30, 53).

The cited portions of Russell disclose:

[0030] As a management function of the controller, the software periodically checks the parent/child account and reviews balances to determine if the account balance is low. If so, the software generates an electronic or paper message to the parent notifying him that it is time to replenish the account. Other management functions of the controller include, but are not limited to, analytical reviews of the account for detection of fraud and abuse, **automatic replenishment** of the parent/child account, item and inventory accounting, sales tracking, and systematic electronic downloading of data from the controller to institutions and vendors.

The child/master database 250 contains information on each child, such as the child's name, address, social security number, date of birth, school district, school, current grade level, daily spending limits, type items the child may purchase, minimum account replenishment level balance needed before notification of parent. It also contains the social security numbers of the parents authorized to fund the child's account.

The cited sections, while disclosing automatic replenishment generally, do not disclose the specific limitation of the claim, i.e.:

... automatically add funds to the subaccount during a transaction if a balance falls below a minimum balance ...

Further, as with other rejections under 35 U.S.C. §103 in this application, the Final OA does not provide a sufficient explanation for combining the references. In each case of rejection under §103, the Final OA recites:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow <Reference #1>'s teaching to include the feature of <the limitation asserted to be disclosed by Reference #2> as taught by <Reference #2> for <the utility asserted by applicant> .

Under this rationale, any collection of disclosures (however unrelated) reciting the elements of a claim can be asserted to render a truly useful/novel/non-obvious invention *prima facie* unpatentable, thereby inappropriately shifting the burden to the applicant. Since all but a very few of otherwise patentable inventions are combinations of known elements, virtually nothing would be patentable if such a formulaic rationale were sufficient to establish a *prima facie* case of unpatentability.

Given that the references do not disclose a limitation of the claim, a *prima facie* case of unpatentability has not been stated. Therefore, the undersigned requests that the rejection be withdrawn

Regarding Claim 9, that claim is allowable as dependent on Claim 1 as amended.

Regarding Claim 10, at P05 the Final OA asserts that Russell teaches:

... notification to the user of the primary account when predetermined types of transactions are made in the primary account or in the sub-account. ... Russell ... (¶74-76).

The only disclosure directed to notification on occurrence of predetermined types of transactions in the cited portions of RUSSELL is as follows (**bold** emphasis added):

[0074] ... central controller/trustee 200 then posts a **notice to the child's account** that an attempt to overdraw the account occurred. The parent will then be able to see the attempted transaction at any time he reviews the account.

[0075] ... If there are restrictions preventing the child from making the purchase **the vendor is notified** ... the transaction is terminated 920. The controller/trustee 200 then posts a **notice to the child's account** that a disallowed attempt to purchase has occurred 930.

[0076] If no restrictions ... **the vendor is notified** ... If the amount is less than the minimum notification amount, **a notice is generated to the child's parent that the account need replenishment soon 980**. The notice generated may be in the form of electronic mail (e-mail)m by written **notice sent by common carrier mail, by posting a notification to the child's account, or even in the form of a telephone call**.

From this disclosure, the only notice sent to a parent is that a child's account is nearing the need for replenishment. Even this notice is not notice of a predetermined type of transaction, it's a notice of an anticipated consequence of continuing to charge the account. The references do not disclose sending notification to the user of the primary account when predetermined types of transactions are made.

Regarding Claim 11, at P06 the Final OA asserts that RUSSELL Figure 11, teaches:

... notification to the user of the primary account, the notification including a link that the user may activate to lock the sub-account.

The cited portion of RUSSELL discloses:

PARENT READS NOTICE FROM INSTITUTION AFTER LOGGING ONOT
PARENT/STUDENT ACCOUNT AND HAS THE OPTION TO FUND THE EVENT
DIRECTLY THROUGH THE CONTROLLER 1125

This is not disclosure that the notification itself contains as link that the user may activate to perform any function. Absent such disclosure, the Final OA does not state a *prima facie* case of unpatentability for this claim. Consequently, the undersigned requests that this rejection be withdrawn.

Regarding Rejection of Claims 5 and 7 as Unpatentable over ROWE in View of COHEN.

Regarding Claim 5, at P06 the Final OA asserts that COHEN ¶202 discloses:

... the service provider computer is programmed to permit the user to authorize the sub-account to establish a further sub-account subordinate to the sub-account.

COHEN ¶202 discloses:

As another example, a parent could give a teenage child a card to go out and make a specific purchase for the child or for the parent. The card could be valid only for purchase on that particular day, to a certain designated purchase limit, and even, if desired only in a certain store, or group of stores or types of stores (e.g. clothing stores), or types of purchases or items. The main account could have, for example, a \$1500 credit card limit, but the parent could set a \$100 limit for use of the customized card on that particular day. Thus, if the card is lost or stolen, the card can not be used at stores other than the types chosen by the parent. Use in any other type of store or on any day other than that one day will cause the card to be declined. This minimizes the amount of credit card loss which can occur, and increases the chances of catching the thief. Likewise, the sublimit of \$100 also minimizes the amount of loss which is possible.

While COHEN discloses a card and various limits that can be applied to the card, COHEN does not disclose authorizing the sub-account to establish a new sub-account subordinate to the first sub-account. Absent such disclosure, the Final OA does not state a *prima facie* case of unpatentability for this claim. Consequently, the undersigned requests that this rejection be withdrawn.

Regarding Claim 7, that claim is allowable at least in part as being dependent on Claim 1 as amended.

CONCLUSION

The foregoing is submitted as a full and complete response to the Final OA mailed 06/19/2008. With consideration of the above remarks and amendments, the undersigned submits that this application is in condition for allowance, and such disposition is earnestly solicited.

The Final OA contains characterizations of the claims and the references with which the Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Final OA. In discussing the specification, claims, and drawings in this Reply, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted to the maximum extent permitted by statute, regulation, and applicable case law.

The undersigned believes that the prosecution might be advanced by discussing the application with the Examiner. The undersigned requests a telephone interview with the Examiner at the Examiner's earliest convenience.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504402, and please credit any excess fees to such deposit account.

Respectfully submitted,

Date: December 19, 2008

By: /Michael J. Dimino, 44,657/
Michael J. Dimino
Registration No. 44,657

KING & SPALDING LLP
1700 Pennsylvania Avenue NW
Suite 200
Washington, D.C. 20006
(202) 714-5007